

REMARKS

The following remarks are prepared in response to the Office Action of December 11, 2006. Claims 1-21 are pending in this application, after entry of this amendment. Claims 1, 2, 9, 10 and 12 were amended herein. Claims 20 and 21 have been added. Reconsideration in light of the remarks made herein is respectfully requested.

The Office Action rejected Claims 1-8 and 12 under 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1, 2 and 12 have been amended to address the rejection under §112, ¶ 2 and not for the purpose of distinguishing over any prior art. Accordingly, Applicant respectfully request that the rejection be withdrawn.

The Office Action contends that Claims 1-8 and 10-19 are obvious over a combination of *Shirasawa*. (U.S. Patent No. 5,355,988) in view of *Watanabe et al.* (U.S. Patent No. 5,135,433).

Applicant respectfully traverses this contention.

The coin separating unit of independent Claim 1 includes:

[A] a coin transporting unit for receiving coins of different size on a support surface that translates the coins for subsequent processing, the support surface having a predetermined flexibility and friction characteristic to engage the coins for translation and to enable coin movement transverse to a direction of movement;

[B] a separating roller unit positioned above the support surface at a distance no greater than twice the thickness of the coins to be separated, the surface of the separating roller unit closest to the support surface moving in a direction opposite to the movement of the support surface; and

[C] a supporter unit operatively located upstream of the separating roller unit, relative to movement of the support surface and adjacent the separating roller unit, the supporter unit is movably located above the support surface by a distance which approximates the thickness of the coins to be separated wherein the supporter unit can move transverse to

the support surface when engaging a coin and can assist in preventing more than one coin from passing beneath it before the coin engages the separating roller unit and the flexibility of the support surface accommodates relative movement of a coin to assist in preventing coin jams.

According to the present invention, the coin separating unit has a coin transporting unit 18 in [A] that receives coins of "different size." "The coin separating unit can separate ... coins one by one despite various thickness differences between different types of coins." (specification, paragraph 0004). The coin separating unit also has a supporter unit 22 in [C] "located upstream of the separating roller unit," capable of moving "transverse to the support surface when engaging a coin," and capable of "preventing more than one coin from passing underneath."

The *Shirasawa* reference is directed to a "device for supplying coins to a coin-operated gaming machine in order to play a game" (col. 1, lines 7-10). The coin supply device 13 includes a separating roller 36 that has "a spacing D together with the first conveyor belt described by the relation $T < D < 2T$ where T is the thickness of a coin or token of a predetermined type" (col. 1, lines 59-61).

The *Watanabe* reference is directed to a coin sorting apparatus that determines the face value of coins, examines the genuineness of coins and drops the coins through a sort-out opening other than those of the determination it is desired to retain (col. 1, lines 5-9). The coin sorting apparatus has a coin feeding belt 4 that "is disposed above and parallel to" a coin guideway 3 (col. 4, lines 26). The coin sorting apparatus has rollers 15a and 15b that are biased downward by springs to press the coin feeding belt 4 (col. 5, lines 25-27).

Neither the *Shirasawa* reference, nor the *Watanabe* reference discloses, teaches or suggests a supporter unit located upstream of the separating roller unit, capable of moving transverse to the support surface when engaging a coin, and capable of preventing more than one

coin from passing underneath. The supporter unit as recited in Claim 1 is located upstream of the separating unit and moves transverse to the support surface to achieve its intended purpose of preventing more than one coin from passing underneath.

In MPEP 2143.01, the Examiners are instructed as follows:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Rollers 15a and 15b of the *Watanabe* reference are not located upstream of the separating roller unit, as recited in Claim 1. In fact, the *Watanabe* reference does not disclose, teach or suggest a separating roller unit. Rollers 15a and 15b only applies a downward bias to the coin feeding belt 4 without coming into contact with any coin. Consequently, rollers 15a and 15b are used for a different purpose.

Since rollers 15a and 15b do not “engage” any coin, the rollers fail to “prevent more than one coin from passing underneath.” The *Shirasawa* reference does not remedy the deficiencies of the *Watanabe* reference. Hence, both references fail to recite the structural and functional limitations of Claim 1.

As noted in MPEP § 2173.05(g), “a functional limitation is an attempt to define something by what it does, rather than by what it is.” Under MPEP § 2173.05(g), a patentee has a right to define “some part of an invention in functional terms.” Moreover, MPEP § 2173.05(g) notes that “there is nothing inherently wrong with defining some part of an invention in functional terms.”

Thus, Claim 1 of the present invention is not obvious over a combination of *Shirasawa* in view of *Watanabe*.

Claims 2-8 depend from Claim 1. Thus, these claims are patentably distinct from the prior art references for the same reasons advanced above with respect to Claim 1.

Independent Claim 10 is patentably distinct from the prior art references for the same reasons advanced above with respect to Claim 1. Claim 10 recites a “supporter roller unit, operatively located upstream of the separating roller unit and adjacent the separating roller unit, including at least one supporter roller unit rotably mounted to contact any overlaying coins and assist in permitting the underlaying coin to pass to the separating roller unit while displacing the overlaying coin, wherein the coins can pass beneath the separating roller unit and the rotating belt can flex to increase the distance beneath the separating roller unit as the coin passes underneath.” Neither the *Shirasawa* reference, nor the *Watanabe* reference discloses, teaches or suggests a supporter unit operatively located upstream of the separating roller unit and adjacent the separating roller unit, and is in contact with the overlaying coins.

Independent Claim 11 is patentably distinct from the prior art references for the same reasons advanced above with respect to Claim 1. Claim 11 also recites that “the coin transporting unit and the separating roller can move relative for increasing the distance.” The separating roller 47 of the *Shirasawa* reference is “secured to the shaft 46.” The *Shirasawa* reference does not disclose, teach or suggest that the separating roller can move in a direction that increases the relative distance with the coin transporting unit. The *Watanabe* reference does not disclose, teach or suggest a separating roller. Hence, Claim 11 of the present invention is not obvious over a combination of *Shirasawa* in view of *Watanabe*.

Claims 12-21 depend from Claim 11. Thus, these claims are patentably distinct from the prior art references for the same reasons advanced above with respect to Claim 11.

The Office Action contends that Claim 9 is obvious over a combination of *Furukawa* (U.S. Patent No. 6,086,472) in view of *Watanabe et al.* (U.S. Patent No. 5,135,433).

Applicant respectfully traverses this contention.

The coin separating assembly of amended Claim 9 includes:

a coin hopper for receiving various coins of different sizes in bulk;

a rotating belt positioned under the coin hopper for receiving coins from the coin hopper by a gravity feed, the rotating belt has a pivoting support member with an elongated surface for supporting an underside of the rotating belt;

a separating roller unit positioned above the rotating belt at a distance no greater than twice the thickness of the coins to be separated, the surface of the separating roller unit closest to the rotating belt moving in a direction opposite to the movement of the support surface,

wherein the rotating belt has a predetermined flexibility to enable a coin to be pushed by the separating roller unit into the rotating belt and the pivoting support member can accommodate the coin movement transverse to the directional movement of the belt by tilting the elongated surface on the underside of the rotating belt.

According to the present invention, "when belt 30 is pushed downwards over a predetermined amount, belt supporter 72 moves downwards to a predetermined distance. The end of belt supporter 72, below separating roller 20, slants relative to belt 30 and surface 44 for the coins" (specification, para. 0049).

The *Watanabe* reference does not disclose, teach or suggest "a pivoting support member with an elongated surface for supporting an underside of the rotating belt" and "can accommodate the coin movement transverse to the directional movement of the belt by tilting the elongated surface on the underside of the rotating belt." The belt 4 of the *Watanabe* reference does not accommodate coin movement by tilting due to the separating roller pushing on a coin.

It is presumed that the *Furukawa* reference actually is cited simply for the teaching of a coin hopper 11 and a rotating belt 12. The present invention does not purport to be an inventor of the coin hopper and the rotating belt. The present invention, however, utilizes such known

features to provide a coin separating assembly with a pivoting support member that can "accommodate the coin movement transverse to the directional movement of the belt by tilting the elongated surface on the underside of the rotating belt." Adding the teaching of the *Furakawa* reference into the *Watanabe* reference does not suggest this combination nor the advantages of the present invention. *Furakawa* does not satisfy the deficiencies of the *Watanabe* reference.

Applicant accordingly submits that the present invention is more than adequately distinguished over any combination of the references of record by the presently pending claims, and is worthy of patent protection.

If the Examiner believes a telephone interview will help further the prosecution of this case, the undersigned attorney can be contacted at the listed telephone number.

Very truly yours,

SNELL & WILMER L.L.P.



Joseph W. Price
Registration No. 25,124
600 Anton Boulevard, Suite 1400
Costa Mesa, California 92626-7689
Telephone: (714) 427-7420
Facsimile: (714) 427-7799